

REMARKS / ARGUMENTS

I. General Remarks

Please consider the application in view of the following remarks. Applicants thank the Examiner for her careful consideration of this application.

Applicants hereby request continued examination of this application, in accordance with 37 C.F.R. § 1.114. Applicants respectfully request that the amendments presented in the previously-filed Response to Advisory Action Mailed March 1, 2007 (filed April 4, 2007) (hereinafter “the April 4, 2007 Response”), and reproduced herein, be entered, and further request consideration of the claims in light of the amendments and remarks contained herein. The remarks and arguments submitted in the April 4, 2007 Response are incorporated by reference into this Response. A copy of the April 4, 2007 Response is included with this filing for the Examiner’s convenience.

II. Disposition of Claims

Claims 1-83 are pending in this application.

In the Final Office Action, claims 1-83 were rejected under 35 U.S.C. § 102(e) and 35 U.S.C. § 102(a).

In this response, claims 1, 2, 5-7, 11, 12, 42, 43, 45-49, 51-53, 55, 64, 65, 67-71, 73-75, and 77 have been amended herein. These amendments are supported by the specification as filed, and by the applications to which the present application claims priority.

III. Remarks Regarding Examiner’s Objections to the Amendments to the Claims

In the April 18, 2007 Advisory Action, the Examiner also refused to enter the amendments as presented in the April 4, 2007 Response on the grounds that the amendments requires further search and consideration. (*See* Advisory Action at “NOTE”.) Applicants note that the specification as filed supports this amendment. Therefore, Applicants respectfully request that the Examiner now enter Applicants’ proposed amendments to the claims and consider the remarks presented in their April 4, 2007 Response, as presented in this RCE and Response.

IV. Remarks Regarding Rejections of Claims

A. Rejections of Claims Under 35 U.S.C. § 102(e)

Claims 1-83 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0228985 by Taylor *et al.* (“US2003/0228985”). With respect to these rejections, the Final Office Action states:

US2003/0228985 discloses, with respect to all the claims, a method of treating a subterranean formation comprising: providing a gelled liquid hydrocarbon treatment fluid comprising a liquid hydrocarbon and a gelling agent that comprises a polyvalent metal salt of an organophosphonic acid ester or a polyvalent metal salt of an organophosphinic acid, and treating the subterranean formation with the gelled liquid hydrocarbon treatment fluid. See the entire document, especially paragraphs [0008-0021] and [0023-0057], claims 1-41, and examples 1-12.

(Final Office Action at ¶ 2.) In response to Applicants’ previous arguments regarding these claims, the Final Office Action further states:

Applicant’s arguments filed 9/21/06 have been fully considered but they are not persuasive. Applicant argues that since he claims priority back to February 23, 2001, that neither of the cited references constitute prior art. When, in fact, the instant application is a continuation-in-part of the cited applications and the subject matter of the instant invention is not supported within either application. The subject matter including providing “a gelled liquid hydrocarbon...gelling agent that comprises a polyvalent metal salt of an organophosphonic acid ester or a polyvalent metal salt of an organophosphinic acid,” which is the crux of the invention, is new material and is given the benefit of the filing date of the instant application (1/28/2004). Therefore, the cited references constitute prior art in this application because the new material is not supported by the application with the 2/23/2001 filing date.

(Final Office Action at ¶ 4.)

In the February 7, 2007 Amendment, Applicants amended independent claims 1, 42, and 64 to require that the gelling agent comprise a polyvalent metal salt of an organophosphonic acid ester, and argued that, because Applicants claim priority for these claims from U.S. Patent Application Serial No. 09/792,165 (“the ‘165 Application”), the filing of which pre-dates US2003/0228985, US2003/0228985 does not constitute prior art to Applicants’ claims. In response to this amendment, the March 1, 2007 Advisory Action states:

Applicant argues that the 09/792,165 application (US 6,544,934) provides support for “a polyvalent metal salt of an organophosphonic acid ester,” when there is no such mention of “organophosphonic” in the disclosure of the US patent. The US patent 6,544,934 appears to support a “phosphonic” acid ester instead. Further, the CIP application 10/409,240 supports the “phosphonic” terminology as well.

(March 1, 2007 Advisory Action at Continuation of 3.) In this response, Applicants have amended claims 1, 5-7, 42, 45-49, 51, 64, 67-71, and 73 to replace the term “organophosphonic” with the term “phosphonic”, which, as the Examiner notes in the Advisory Action, is supported in the parent '165 Application that pre-dates the effective date of *US2003/0228985*. Therefore, Applicants respectfully submit that *US2003/0228985* does not constitute prior art to Applicants' claims, as amended herein, and Applicants respectfully request the withdrawal of the rejections over this reference.

B. Rejections of Claims Under 35 U.S.C. § 102(a)

Claims 1-83 stand rejected under 35 U.S.C. § 102(a) as being anticipated by European Patent Application Publication No. EP 1236863 by Taylor *et al.* (“*EP1236863*”). With respect to these rejections, the Final Office Action states:

EP 1236863 discloses, with respect to all the claims, a method of treating a subterranean formation comprising: providing a gelled liquid hydrocarbon treatment fluid comprising a liquid hydrocarbon and a gelling agent that comprises a polyvalent metal salt of an organophosphonic acid ester or a polyvalent metal salt of an organophosphinic acid, and treating the subterranean formation with the gelled liquid hydrocarbon treatment fluid. See the entire document, especially paragraphs [0001-0035] claims 1-14, and examples 1-10.

(Final Office Action at ¶ 3.) In response to Applicants' previous arguments regarding these claims, the Final Office Action further states:

Applicant's arguments filed 9/21/06 have been fully considered but they are not persuasive. Applicant argues that since he claims priority back to February 23, 2001, that neither of the cited references constitute prior art. When, in fact, the instant application is a continuation-in-part of the cited applications and the subject matter of the instant invention is not supported within either application. The subject matter including providing “a gelled liquid hydrocarbon...gelling agent that comprises a polyvalent metal salt of an organophosphonic acid ester or a polyvalent metal salt of an organophosphinic acid,” which is the

crux of the invention, is new material and is given the benefit of the filing date of the instant application (1/28/2004). Therefore, the cited references constitute prior art in this application because the new material is not supported by the application with the 2/23/2001 filing date.

(Final Office Action at ¶ 4.)

In the February 7, 2007 Amendment, Applicants amended independent claims 1, 42, and 64 to require that the gelling agent comprise a polyvalent metal salt of an organophosphonic acid ester, and argued that, because Applicants claim priority for these claims from U.S. Patent Application Serial No. 09/792,165 (“the ‘165 Application”), the filing of which pre-dates *EP1236863*, *EP1236863* does not constitute prior art to Applicants’ claims. In response to this amendment, the March 1, 2007 Advisory Action states:

Applicant argues that the 09/792,165 application (US 6,544,934) provides support for “a polyvalent metal salt of an organophosphonic acid ester,” when there is no such mention of “organophosphonic” in the disclosure of the US patent. The US patent 6,544,934 appears to support a “phosphonic” acid ester instead. Further, the CIP application 10/409,240 supports the “phosphonic” terminology as well.

(March 1, 2007 Advisory Action at Continuation of 3.) In this response, Applicants have amended claims 1, 5-7, 42, 45-49, 51, 64, 67-71, and 73 to replace the term “organophosphonic” with the term “phosphonic”, which, as the Examiner notes in the Advisory Action, is supported in the parent ‘165 Application that pre-dates the effective date of *EP1236863*. Therefore, Applicants respectfully submit that *EP1236863* does not constitute prior art to Applicants’ claims, as amended herein, and Applicants respectfully request the withdrawal of the rejections over this reference.

IV. No Waiver

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example arguments sufficient to overcome the Examiner’s § 102(e) and § 102(a) rejections. Other arguments may exist, and Applicants reserve the right to present these additional arguments in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements. The reasons discussed by Applicants are sufficient to overcome the § 102(e) and § 102(a) rejections.

**SUMMARY AND PETITION FOR EXTENSION OF TIME OF ONE-MONTH
TO FILE THIS RCE**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

The Advisory Action states that the deadline for this Response is the later of the deadline for response set in the Final Office Action (March 8, 2007) or the mailing date of the April 18, 2007 Advisory Action (April 18, 2007). Applicants hereby petition under the provisions of 37 C.F.R. § 1.136(a) for a one-month extension of time to file this RCE, from April 18, 2007 to May 18, 2007.

The Commissioner is hereby authorized to debit the Deposit Account of Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.1041, in the amount of \$910.00 for the RCE fee of \$790.00 under 37 C.F.R. § 1.117(e), and for the fee for the One-Month Petition for Extension of Time to File this Response of \$120.00 under 37 C.F.R. § 1.117(a)(1). Should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a petition therefor, and direct that any additional fees be charged to the Deposit Account of Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.1041.

Respectfully submitted,



Elizabeth L. Durham
Registration No. 59,509
BAKER BOTTS L.L.P.
One Shell Plaza
910 Louisiana
Houston, TX 77002
Telephone: 713.229.2104
Facsimile: 713.229.7704
Email: liz.durham@bakerbotts.com

Date: May 1, 2007